

REMARKS

I. Introduction

With the addition of new claim 26, claims 12 to 26 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Objection to the Drawings

The drawings were objected under 37 C.F.R. 1.83(a) to for allegedly failing to show every feature specified in the claims. In this regard, Applicants note that that the damping disk 50, which is described as being optionally “radially or obliquely slotted at a point along its circumference” (Specification at page 5, lines 6 to 8) is schematically illustrated in Figures 1, 2, and 3. Thus, it is respectfully submitted that the schematic illustration of damping disk 50 in Figures 1, 2, and 3 satisfies the requirements of 37 C.F.R. 1.83(a). Accordingly, withdrawal of this objection is respectfully requested.

III. Rejection of Claims 12, 13, 18, 22, and 23 Under 35 U.S.C. § 102(b)

Claims 12, 13, 18, 22, and 23 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,967,487 (“Cook et al.”). It is respectfully submitted that Cook et al. does not anticipate these claims for at least the following reasons.

Claim 12 relates to a solenoid valve and recites: a valve housing including at least one feed channel and at least one discharge channel; an electromagnetically switched valve member that establishes a connection between the at least one feed channel and the at least one discharge channel in a first switch position and blocks the connection in a second switch position; a magnet coil including a guide bushing that is inserted into an expanded part of an opening of the magnet coil that is delimited by an annular shoulder; an armature to which is rigidly

connected the valve member and capable of movement by displacing fluid in the guide bushing; and a damping disk surrounding the armature and situated between the annular shoulder and an adjacent face end of the guide bushing. Although Applicants do not necessarily agree with the merits of the present rejection, to facilitate prosecution, claim 12 has been amended herein without prejudice to recite that the **damping disk is configured to dampen the movement of the armature by restriction of a flow of fluid through an annular gap between an inner circumference of the damping disk and an outer circumference of the armature**. Support for this amendment may be found, for example, at page 5, lines 11 to 20.

Cook et al. relates to an automotive emission control valve. The Examiner contends at page 3 of the Office Action that element 80 constitutes a damping disk and element 58 is an armature. However, element 80 does not have any damping effect on element 58. See, e.g., col. 4, lines 56 to 58. Moreover, there is no indication that element 80 is configured to restrict a flow of fluid through an annular gap between an inner circumference of element 80 and an outer circumference of element 58. In this regard, Cook et al. does not disclose, or even suggest, a damping disk that is configured to dampen the movement of the armature by restriction of a flow of fluid through an annular gap between an inner circumference of the damping disk and an outer circumference of the armature.

As indicated above, Cook et al. does not disclose, or even suggest, all of the features recited in claim 12. As such, it is respectfully submitted that Cook et al. does not anticipate claim 12 or any of claims 13, 18, 22, and 23, which depend from claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 12 and 16 to 18 Under 35 U.S.C. § 102(b)

Claims 12 and 16 to 18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,947,442 ("Shurman et al."). It is respectfully submitted that Shurman et al. does not anticipate these claims for at least the following reasons.

Shurman et al. relates to a solenoid actuated valve assembly. The Examiner contends at page 4 of the Office Action that element 79 of Shurman et al. constitutes a damping disk and elements 64 and 78 constitute an armature. According to Shurman et al., element 79 performs a damping function by dictating a

flow through flow path 106, illustrated in Figure 3. See col. 8, lines 7 to 32. It is noted, however, that flow path 106 does not extend through an annular gap between an inner circumference of element 79 and an outer circumference of elements 64 and 78. In this regard, Shurman et al. does not disclose, or even suggest, a damping disk that is configured to dampen the movement of the armature by restriction of a flow of fluid through an annular gap between an inner circumference of the damping disk and an outer circumference of the armature.

As indicated above, Shurman et al. does not disclose, or even suggest, all of the features of claim 12. As such, it is respectfully submitted that Shurman et al. does not anticipate claim 12 or any of claims 16 to 18, which depend from claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 14, 15, 24, and 25 Under 35 U.S.C. § 103(a)

Claims 14, 15, 24, and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Cook et al. in view of “engineering expedient.” It is respectfully submitted that Cook et al. in view of “engineering expedient” does not render unpatentable these claims for at least the following reasons.

As an initial matter, the reliance on “engineering expedient” is not supported and is apparently based on the personal knowledge of the Examiner and/or what the Examiner considers to be well known fact. In this regard, Applicants respectfully traverse this contention of “engineering expedient” to the extent it is maintained and requests that the Examiner provide specific evidence to establish any such assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions.

Claims 14, 15, 24, and 25 depend from claim 12 and therefore include all of the features of claim 12. As set forth above, Cook et al. does not disclose, or even suggest, all of the features recited in claim 12. The alleged “engineering expedient” does not cure the critical deficiencies of Cook et al. with respect to the features of claim 12. As such, it is respectfully submitted that Cook et al. in view of the alleged “engineering expedient” does not render unpatentable the present claims. Accordingly, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claim 19 Under
35 U.S.C. § 103(a) -- Cook et al. and Gauthier et al.**

Claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Cook et al. and U.S. Patent No. 4,793,372 ("Gauthier et al."). It is respectfully submitted that the combination of Cook et al. and Gauthier et al. does not render unpatentable claim 19 for at least the following reasons.

Claim 19 depends from claim 12 and therefore includes all of the features of claim 12. As set forth above, Cook et al. does not disclose, or even suggest, all of the features of claim 12. Gauthier et al. is not relied upon for disclosing the features of claim 12 not disclosed or suggested by Cook et al. Indeed, Gauthier et al. does not disclose, or even suggest, the features of claim 12 not disclosed or suggested by Cook et al.

As indicated above, the combination of Cook et al. and Gauthier et al. does not disclose, or even suggest, all of the features recited in claim 19. As such, it is respectfully submitted that the combination of Cook et al. and Gauthier et al. does not render unpatentable claim 19. Accordingly, withdrawal of this rejection is respectfully requested.

**VII. Rejection of Claim 19 Under
35 U.S.C. § 103(a) -- Shurman et al. and Gauthier et al.**

Claim 19 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shurman et al. and Gauthier et al. It is respectfully submitted that the combination of Sherman et al. and Gauthier et al. does not render unpatentable claim 19 for at least the following reasons.

Claim 19 depends from claim 12 and therefore includes all of the features of claim 12. As set forth above, Shurman et al. does not disclose, or even suggest, all of the features of claim 12. Gauthier et al. is not relied upon for disclosing the features of claim 12 not disclosed or suggested by Shurman et al. Indeed, Gauthier et al. does not disclose, or even suggest, the features of claim 12 not disclosed or suggested by Shurman et al.

As indicated above, the combination of Shurman et al. and Gauthier et al. does not disclose, or even suggest, all of the features recited in claim 19. As such, it is respectfully submitted that the combination of Shurman et al. and Gauthier

et al. does not render unpatentable claim 19. Accordingly, withdrawal of this rejection is respectfully requested.

VIII. New Claim 26

New claim 26 has been added. It is respectfully submitted that new claim 26 adds no new matter and is fully supported by the present application, including the Specification. Support may be found, for example, at page 5, lines 11 to 20 of the Specification.

Since claim 26 depends from claim 12 and therefore includes all of the features of claim 12, it is respectfully submitted that claim 26 is patentable over the references relied upon for at least the same reasons set forth above in support of the patentability of claim 12.

IX. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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